

## **REMARKS**

As a preliminary matter, Applicants thank the Examiner for the allowance of claims 17 and 18, and the continued allowance of claims 1-2 and 4-8.

With respect to rejected claims 9 and 19-20, claim 19 has been cancelled without prejudice herein, rendering all rejections to this claim now moot. With respect to claims 9 and 20, however, because the Examiner merely repeats the previous rejections, Applicants incorporate by reference herein all of those arguments presented in the previous responses, and particularly those from Amendment G, filed October 14, 2005. Applicants respectfully request that the Examiner reconsider those arguments with respect to claims 9 and 20, and withdraw the rejections to these claims. Applicants additionally request that the Examiner consider the following arguments as well with respect to these claims.

With respect to the repeated rejection of claim 9 based on the von Gutfeld reference (U.S. 6,179,679), the Examiner continues to assert that the single sided surface of the reflector 401 in the reference somehow anticipates the recited concavo-convex structure of the present invention that is also recited to have inclined surfaces. These assertions, however, are incorrect, as clearly shown by von Gutfeld. The Examiner further incorrectly asserts that von Gutfeld somehow teaches that the reflector 401 is formed only under the sealing material 101. In fact, Von Gutfeld fails to teach (or suggest) anything of the sort.

The Examiner has not properly characterized von Gutfeld's reflector 401. The Examiner insists that von Gutfeld "clearly shows" that the reflector 401 is formed *only* in the area under the sealing material 101. Von Gutfeld, however, teaches no such limitations. The

reflector 401 is only shown in Fig. 4, which drawing shows only a side view of the *lengthwise direction* of the sealing material 101. This drawing does not show whether or not the reflector 401 is *also* limited to the area under the sealing material 101 in the *width direction*. The layer 401 and material 101 are simply never shown together (or described) in the width direction, which would be perpendicular to the view shown in Fig. 4.

Fig. 20a of the present invention, on the other hand, shows the width perspective. The concavo-convex structure to the light reflection layer of the present invention is clearly illustrated in this drawing, and the area under the seal is specifically shown to be only under the seal in its width direction. The word “only,” as here recited in claim 9 of the present invention, includes the width direction under the seal by definition. Von Gutfeld even appears to teach away from such features by expressly teaching that the “reflector 401 is positioned below the substrate 104” (col. 4, lines 28-29, emphasis added), but not anything about being positioned “below the strip 101.” The substrate 104 is clearly shown to be considerably larger than the sealant strip 101.

Von Gutfeld simply does not teach (or suggest) any other limitation to the dimensions of its reflector 401. Even though the Examiner asserts that von Gutfeld *could be* further limited to read upon the claims of the present invention, such personal knowledge and speculation by the Examiner are not relevant to the patentability of claim 9. Patentability may only be determined according to affirmative teachings or suggestions in the prior art. Fig. 4 of von Gutfeld shows nothing more than that the reflector 401 is formed *under* the sealant strip 101 along its length. Von Gutfeld is entirely silent, however, about where the reflector

401 is not formed with respect to the strip 101, and therefore the Section 102 rejection of claim 9 based on this reference cannot be maintained. Rejections (under either of Sections 102 and 103) cannot be established and maintained based on mere probabilities and possibilities alone. See also Section 2143.01 of the MPEP.

The Examiner's other assertion regarding claim 9 is incorrect, namely, that the smooth or roughened surface to von Gutfeld's reflection layer 401 somehow reads upon the limitations of claim 9 of the present invention reciting a "concavo-convex structure which has inclined surfaces." Von Gutfeld clearly teaches (col. 4, lines 24-36) only that the reflector 401 can have either a *smooth surface*, or *micron-sized asperities*. No person of ordinary skill in the art would reasonably interpret von Gutfeld's layer 401 having "micron-sized asperities" to read upon the concavo-convex structure recited by and illustrated in the present Application, which structure is also affirmatively recited to have inclined surfaces. Accordingly, for any and all of these reasons, the rejection of claim 9 should be withdrawn.

With respect to claim 20, the Examiner's assertions regarding what is *possible* to achieve with the elements in the prior art references is irrelevant to the affirmatively recited limitations of claim 20. These limitations, as they appear in claim 20, do not appear to have been given their reasonable patentable weight. For example, the Examiner continues to admit that Nishiguchi (U.S. 6,226,067) teaches that the opening in its seal is optional, but then asserts that Nishiguchi's option to not have the opening means that Nishiguchi *could* provide a suction, as affirmatively recited in the present invention. This reasoning, however, is backwards. Applicants are not required to disprove every possible feature that could be

added to Nishiguchi's device. Instead, the Examiner first has the burden to be able to demonstrate that Nishiguchi affirmatively teaches or suggests those additional features. As explained above, neither anticipation nor obviousness can be established or maintained based only on probabilities or possibilities.

The very fact that Nishiguchi may also form the seal without the optional opening fails, by itself, to demonstrate that Nishiguchi somehow also affirmatively teaches or suggests to provide a suction in an atmosphere. Including Nishiguchi's opening in the seal of the present invention would destroy the suction created. Nishiguchi provides no teaching or suggestion for why one skilled in the art would choose to exclude the opening in the seal. Again, anticipation and obviousness may only be established and maintained according to what is affirmatively taught or suggested by the prior art. In other words, for the rejection to have any merit, Nishiguchi would have to affirmatively teach or suggest the desirability of providing a suction. Nishiguchi, however, does not. The very presence of the opening would destroy the suction. The option to have the opening in the first place destroys the *obviousness* of creating any suction in the first place.

The rejection of claim 20 based on Nishiguchi is only on the theory of obviousness, and as repeatedly pointed out to the Examiner, "obviousness cannot be established by mere probabilities and possibilities." The Examiner has never asserted more than the fact that a suction *could be* included with the structure of Nishiguchi. It was improper for the Examiner to dismiss Applicants' arguments under the theory that Applicants have not disproven the possibilities surmised by the Examiner. The Examiner may not shift

his burden to Applicants when the reference itself does not affirmatively teach or suggest such possibilities. Although repeatedly requested by Applicants, the Examiner has never pointed to any actual evidence that the suction features of the present invention are inherent or obvious from Nishiguchi's disclosure. Accordingly, the rejection of claim 20 based on Nishiguchi is still deficient, and must be withdrawn.

A similar problem exists with the Examiner's rejection of claim 20 under Section 102 based on Hirakata et al. (U.S. 6,465,268). The Examiner acknowledges that Hirakata fails to teach or suggest any suction, but the Examiner again merely dismisses these features of the present invention by asserting that Hirakata otherwise "has the same structure" of the present invention, and that therefore *any* function of the present invention is necessarily inherent with Hirakata. This reasoning, however, is unsound, and it is not supported by the Hirakata reference. Hirakata does not teach the "same structure" as the present invention. Hirakata's gap retaining members 731, 732, for example, are unable to function as a suction because the gap that is formed between the substrates, in the areas occupied by these two retaining members, may not vary.

As previously discussed, the mere fact that two structural elements *appear* similar, it does not necessarily follow that these two elements always have the same inherent features, properties, and characteristics. For example, if the present invention claimed a "frame shape magnet," and a prior art reference only taught a "metal frame," it would be entirely incorrect to assert that these two structures are identical, or have "identical structures," merely because both are metal and in the shape of a frame. The attractive

properties to the magnet would also be structural characteristics that would not be inherently present with any metal frame having the same general shape. Even though the metal frame in this example could also “function” as a magnet, the attractive properties of the magnet would not only be functional limitations. Such is the case with the present rejection.

The suction limitations recited in claim 20, with respect to the sealing material, are structural properties of the material that are (admittedly by the Examiner) not taught or suggested in Hirakata or Nishiguchi. It was improper for the Examiner to dismiss these limitations under Section 2114 of the MPEP. Section 2114 only requires that apparatus claims must be structurally distinguishable from the prior art. Section 2114 does not, however, justify the dismissal of all structural claim features that may *also* imply some functional characteristics to the structure. The Examiner is still required to give proper consideration to any and all structural characteristics conferred by the same language.

Section 2114 provides two distinguishable examples of cases where purely functional language in a claim did not distinguish the claim from the prior art. Neither example, however, is applicable to the present case. In the example of In re Swinehart, 439 F.2d 210, 212-13, 169 U.S.P.Q.226, 228-29(CCPA 1971), the finding of anticipation was upheld only because the limitations at issue were first actually demonstrated to be inherent in the prior art reference, and not merely presumed from similarities between the two. In the present case, however, the Examiner only presumes that the limitations at issue are inherent to the prior art because of only the visual similarity between the two devices. The Examiner must first demonstrate that the claimed limitations are actually inherent, and not merely just

possibilities, as stated in Section 2143.01. Structural characteristics are not limited to only the topographical geometry of a device. A suction is a physical property of the present invention.

The other example discussed in Section 2114 is also inapplicable to the present case. Ex parte Masham, 2 U.S.P.Q2d, 1647 (Bd. Pat. App. & Inter. 1987) represents a case where the only difference between a claimed device and the prior art was the intended use of the device. Such intended use though, only appeared in the *preamble* of the claim. It is a well-established principle of patent law that claim language in the preamble is given little patentable weight, if any, to begin with. It is further well-established that finding a new use for a known apparatus does not usually entitle the use discoverer to patent an apparatus claim for the newly discovered use. Claim 20 of the present invention, however, does not recite such intended use limitations in the preamble, nor does claim 20 attempt to claim a new use for the recited device.

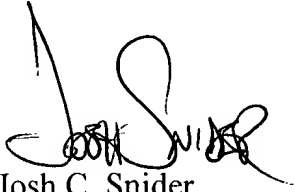
The mere presence of characteristics that may be “functional” for a recited element does not allow the Examiner to automatically dismiss all such limitations. Many such alleged functional limitations necessarily imply structural characteristics on the recited element. A “container,” for example, would be an element that necessarily has the function “to contain” something inside of itself, but the element would still nevertheless have structural characteristics conferred upon it by its very description as a “container.” The same situation is presented by claim 20 of the present invention.

Regardless of the Examiner's interpretation of the alleged "functional" language in claim 20, the Examiner is still obligated to consider the structural material properties necessarily present in the claim. Regardless of which element actually functions as a suction, the recited suction is nevertheless affirmatively present in the claim as a separate and distinct *physical* element of the claim. In other words, the structural material on the inside of the recited sealing material will be at a lower pressure than any structural material (including the air) outside of the sealing material. Even if the Examiner can conceive of more effective language to affirmatively recite such features, these structural features are nevertheless present in claim 20, and must be given patentable consideration. Accordingly, for at least these reasons and those previously discussed, the rejection of claim 20 must also be withdrawn.

For all of the foregoing reasons, Applicants submit that this Application, including claims 1-2, 4-9, and 17-18, and 20 is in condition for allowance, which is again respectfully requested. The Examiner is invited to contact the undersigned Attorney if a further interview would expedite prosecution.

Respectfully submitted,  
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